

PATENT  
450100-03276

### **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-19 are pending in this application. Claims 1, 6, 8, 10, 13, 15 and 18 are independent.

### **II. DOUBLE PATENTING REJECTION**

Claims 1-19 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of co-pending Application No. 09/862,656 in view of U.S. Patent No. 5,617,518 to Kuwamoto et al. (hereinafter, merely "Kuwamoto"). Applicant submits that Kuwamoto does not render the feature "...having a smallest activation count is saved to an external recording medium" obvious. Indeed, as discussed herein, Applicant submits that Kuwamoto teaches away from saving data to an external device.

### **III. REJECTIONS UNDER 35 U.S.C. §103(a)**

Claims 1-19 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Chen (6,360,364) in view of Kanevsky (6,393,470) in view of Kuwamoto. Applicant respectfully traverses the rejection because the combination does not teach or suggest the claimed invention and the combination is improper because it lacks motivation.

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## IV. RESPONSE TO REJECTIONS

A. Combination Does Not Teach Or Suggest The Claimed Invention

Applicant's invention as recited in the independent claims is directed toward an information-processing apparatus, a server, an information communication system, an information-processing method, an information providing medium, an information-processing program and an information-providing program. Each of the claims recites "an application program or a data file...having a smallest activation count." Supporting disclosure can be found in the specification at, for example, page 37, lines 4-15.

Specifically, claim 1 recites, *inter alia*:

"...but if said storage means has no free storage area left in which said application program is allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means." (emphasis added)

The Office Action relies on Kuwamoto to provide a description of this feature. However, Applicant submits that Kuwamoto does not disclose the above-identified feature of claim 1. Indeed, Kuwamoto, rather than providing any teaching of the claimed feature of saving to an external recording medium, teaches away from the claimed invention by describing deleting material.

Specifically, Kuwamoto discloses,

"[i]n the process 903 of the word processor 201, the print program file 700 is produced from the print program 720 in the memory 11 and transmitted to the print server 202. In the processes 1104 and 1107 to receive the print program file 700, when an area in the Hard disc drive device 26 to store the print program file 700 isn't enough (steps 1109, 1110), the print program file 700 whose use frequency is the smallest is deleted by an automatic deleting process 1900. (See Kuwamoto col. 12, lines 50-54, emphasis added)

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**B. The Combination Of References Is Improper**

Thus, not only does the combination of references fail to teach or suggest the claimed features, the combination of Chen, Kanevsky and Kuwamoto is improper because there is no motivation to combine Chen and Kanevsky with Kuwamoto. Indeed, Kuwamoto relates to a word processing apparatus and a printer, while Chen and Kanevsky relate to storing computer applications to a device. Applicant respectfully submits that the combination is the result of impermissible hindsight taken from selected pieces of prior art without any suggestion teaching or motivation to do so. Applicant submits the Office Action used the claimed invention as a blueprint in an attempt to create a mosaic of features.

Therefore, Applicant submits that claim 1 is patentable.

Independent claims 6, 8, 10, 13, 15 and 18 recite similar, or somewhat similar, features and are patentable for similar, or somewhat similar, reasons.

**V. DEPENDENT CLAIMS**

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

**CONCLUSION**

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the

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Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

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In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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